

## **REMARKS**

Claims 1-20 are pending in the application. By amendment Applicant hereby cancels claims 1-20 and submits substitute claims 21-30.

Claim 21 is an independent claim combining the recitations of original claims 1 and 2 with the exception that recitations to poly- $\epsilon$ -caprolactone have been omitted. Since substitute claim 21 combines the recitations of former claims 1 and 2, no new matter has been entered. Claims 22-30 are claims dependent from claim 21.

Claims 1-20 were rejected under 35 U.S.C § 103(a) as allegedly being obvious over Beisang in view of Scopelianos and for various of the claims, further in view of either Ron, Ersek, or Wallace. In view of the cancellation of the claims, the rejections have been rendered moot. Applicants respectfully request withdrawal of the rejections.

The Applicants now discuss the Examiner's arguments in light of the new claims. The Examiner cites Beisang for teaching an injectable implant for human administration consisting of microparticles in a hydrogel. The Examiner notes that Beisang does not teach the properties of the microparticles. The Examiner notes that Scopelianos teaches microparticles as comprising various polymers including poly- $\epsilon$ -caprolactone. New claim 21, from which the remaining claims depend, recites the composition of the microparticles as consisting of lactic acid polymers, glycolic acid polymers, and lactic acid-glycolic acid co-polymers. The recitation "consisting of" specifically excludes components not specifically enumerated. Therefore, Scopelianos, who recite microparticles comprising poly- $\epsilon$ -caprolactone, is disqualified.

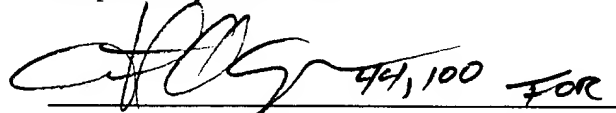
The Examiner notes that Beisang and Scopelianos are both silent as to the properties of the hydrogel. The Examiner cites Ron as teaching CMC and HPMC as gelling agents. An aspect of the present invention is to specifically exclude proteins of animal origin. The present invention specifically recites the absence of any product of animal origin. (Page 5, lines 14-16). Ron et al. teach the use of an injectable gel and/or microsphere as sequestering agents for osteogenic proteins. (Column 2, lines 2-6). Claims 1, 7, 12, and 26, consisting of

the independent claims of Ron et al., recite either "an osteogenic protein" or "BMP-2," a specific osteogenic protein. As discussed above, claim 1 recites "consisting of" thereby excluding the non-enumerated animal proteins from the microparticles. Claims 34 and 35 recite the hydrogel as "consisting essentially of carboxymethylcellulose (CMC) or hydroxypropylmethylcellulose (HPMC)." Therefore, animal proteins are excluded from the hydrogel as well. Thus Ron, which specifically recites proteins of animal origin as components of both the microparticles and the hydrogel is disqualified.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, (MPEP § 2143.03). When evaluating the scope of a claim, every limitation in the claim must be considered. See e.g. *In re Ochiai*, (MPEP § 2144.08). The evidentiary record fails to teach each limitation of the present invention.

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "BA Amernick", followed by the handwritten text "44,100 FOR" and a horizontal line.

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